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HT03-008

Application no. 10/696,431

September 11, 2006

TO: Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 3729 - Examiner Kim Paul D

FROM: Stephen B. Ackerman, Reg. No. 37,761  
28 Davis Avenue  
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/696,431  
File Date: 10/29/2003  
Inventor: Cherng-Chyi Han  
Examiner: Kim, Paul D  
Art Unit: 3729  
Title: Two-Piece Magnetic Shield having Improved Heat Dissipation

#### RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated August 11, 2006. In that office action, restriction was required to one of the following Inventions under

#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on Sept. 11, 2006.

Signature   
Stephen B. Ackerman, Reg. No. 37,761

Date: Sept. 11, 2006

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-4, drawn to a method to improve heat dissipation, classified in class 29, subclass 603.13, and

II - Claims 5-9, drawn to a process to form a magnetic shield, classified in class 29, subclass 603.11, and

III - Claims 10-18, drawn to a process of manufacturing a magnetic read/write head, classified in, classified in class 29, subclass 603.16.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-4, drawn to a process classified in Class 29, subclass 603.13. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner states that Inventions III and Inventions I and II are related as combination and subcombination, and gives as the reasons for distinctness that (1) the

combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. <sup>1</sup> 806.05(c)). However, upon reading the Invention III Claims against the Claims of Inventions I and II, it can be seen that Invention III is drawn to a process to manufacture a magnetic read/write head, while Inventions I and II are drawn to a method to improve heat dissipation in a magnetic shield and a process to form a magnetic shield, respectively. As such, the field of search must necessarily cover both the Group I class/subclass 29/603.13, Group II class/subclass 29/603.11 and Group III class/subclass 29/603.16, in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I, Group II and Group III inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "the combination (Group I) as claimed does not require the particulars of the subcombination (Groups I and II) as claimed because the combination (Group I) as claimed does not require a ferromagnetic layer deposited on a substrate " is speculative and has nothing to do with the Claims as presented in this patent application.

The Examiner further states that Inventions I and II are related as subcombinations disclosed as usable together in a single combination, and gives as the reasons for distinctness that the subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable, and that in the instant case, a subcombination (Group I) has separate utility such as a process of providing a layer of ferromagnetic material on a substrate and a subcombination (Group II) has separate utility such as a process of providing and

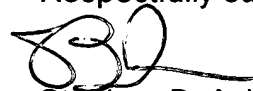
depositing a dielectric layer on a substrate and patterning a thermally conductive layer formed on the dielectric layer (M.P.E.P. 806.05(d)). However, upon reading the Invention I Claims against the Claims of Invention II, it can be seen that Invention I is drawn to a method to improve heat dissipation in a magnetic shield, while Invention II is drawn to a process to form a magnetic shield. As such, the field of search must necessarily cover both the Group I class/subclass 29/603.13, and Group II class/subclass 29/603.11.

Further, it is respectfully suggested that these reasons are insufficient to place the cost of additional Patent Applications upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,



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